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EXAMINER

CHANKONG, DOHM

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2452

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

1. This action is in response to Applicant's amendment filed on 6/9/2009. Claims 1-18 are cancelled. Claims 19-38 are added. Accordingly, claims 19-38 are presented for further examination.

2. During an interview with Applicant's representative, Joe H. Shallenburger, on 8/19/2009, the examiner indicated that the application would be in condition for allowance if the independent claims were amended to include the limitation of dependent claim 28. After carefully reviewing the independent claims, the examiner believes that only claims 19 and 37 are allowable if amended in that fashion. For the reasons stated below, claim 29 would remain rejected even if amended to include the objected limitation.

Additionally, there are § 112 issues that need to be corrected before the claims are in condition for allowance.

3. This is a final rejection.

Allowable Subject Matter

4. Claim 28 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Response to Arguments

5. Applicant's arguments with respect to claims 19-27 and 29-38 have been considered but are not persuasive. As further detailed below, the new claims do not overcome the previously cited Callaghan reference.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 19, 29, and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims contain confusing claim language. For example, with claim 19, the last two limitations are written in the alternative (i.e., determining whether a user purchased a first product OR determining whether the user has purchased a second product, redirecting a user from a second website to a first website OR providing an offer from the second website).

The language is confusing because it is not clear which steps are needed to be performed. Providing an offer from a second website depends on determining that the user has not previously purchased the first product *and* the user has not previously purchased the second product. But the previous limitation did not require making both determinations.

Claim 37 is additionally rejected because it recites "computer readable program code" within a method claim. Appropriate clarification and correction of the claim language is required.

Claim Interpretation

7. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *MPEP* § 2114 (citing *In re Schreiber*, 128 F.3d 1473, 1477-78 (Fed. Cir. 1997)). Moreover, a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Id* (citing *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)).

In other words, limitation of an apparatus claim should be directed to the structural aspects of the apparatus and not its function. Finally, claim scope is not limited by claim language that does not limit a claim to a particular structure. *MPEP* § 2111.04. One example of claim language that may raise a question as to the limiting effect of the language in a claim are "wherein" clauses. *Id*.

Here, system claim 29 is interpreted as an apparatus claim. Claim 29 recites three structural elements: a first processor, a second processor, and a computer. The remaining limitations of claim 29 are wherein clauses and are directed to functional limitations of how to operate the first processor, the second processor, and the computer. As indicated in the cited sections of the MPEP, to read on Applicant's claim 29, a prior art reference need only teach the structural elements and not the functional features.

Thus, the limitations found in the wherein clauses do not limit the claim's scope and are ignore for the purposes of this rejection. Similarly, claim 36 merely recites a functional aspect of

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the claimed system but it does not affect the system's structure. Thus, the limitation in claim 36, as it is currently written, would not render its parent claim patentable.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 19 are rejected under 35 U.S.C. § 102(e) as being anticipated by Callaghan et al, U.S. Patent No. 7.302.402 [“Callaghan”].

9. As to claim 19, Callaghan discloses a computer-method, comprising:

processing or storing information regarding a purchase or an acquisition of a first product or a first service by a user, wherein the information regarding the purchase or the acquisition is processed by or stored by a first processor associated with a first web site, and wherein the

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purchase or the acquisition of the first product or the first service is made in response to an offer associated with the first web site, and further wherein the purchase or the acquisition of the first product or the first service is performed by the user via a computer associated with or used by the user [column 11 «line 62» to column 12 «line 55»: storing a cookie at the user's computer indicating the selected product, Aptiva. The product is offered by a web site, IBM.com];

placing a cookie on the computer, wherein the cookie is placed on the computer by the first web site or by the first processor, and further wherein the cookie contains information regarding the first web site and information indicating that the user has purchased or acquired the first product or the first service from or via the first web site [column 12 «lines 32-55»];

providing a uniform resource locator (URL) offering a second product or a second service, wherein the URL is provided by a second web site or by a second processor associated with the second web site, and further wherein the URL specifies a program on or associated with the second web site [Fig. 8c «items 854-858» | column 12 «lines 56-65»: Lotus.com provides an offer for a second product, Lotus notes];

receiving a signal indicative of an activation of the URL [Fig. 8c «item 854»];

reading or processing information contained in the cookie in response to the activation of the URL, wherein the information contained in the cookie is read or processed using the program [Fig. 8c «item 858»];

determining whether or not the user has previously purchased or acquired the first product or the first service [column 12 «lines 40-44»: determining whether the Aptiva purchase in the shopping cart is a duplicate] *or* determining whether or not the user has previously purchased or acquired the second product or the second service; and

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redirecting the user from the second web site to the first web site if it is determined that the user has previously purchased or acquired the first product or the first service [column 12 «lines 23-31»]: redirecting the user to the original URL based on the existence of the cookie which indicates that the user has already purchased the product (in the shopping cart)] *or* providing an offer from the second web site to sell the second product or the second service to the user if it is determined that the user has not previously purchased or acquired the first product or the first service and that the user has not previously purchased or acquired the second product or the second service.

10. As to claim 20, Callaghan discloses the method further comprising:

sending an e-mail to the computer which includes a link to the URL, providing a web page to the computer which includes a link to the URL [column 11 «lines 45-48»], or providing a computer program to the computer which includes a link to the URL.

11. As to claim 21, Callaghan discloses the method further comprising wherein the activation of the URL comprises a clicking of a link to the URL on a web page [column 11 «lines 45-48»], a clicking of a link to the URL in an e-mail, or an executing of a computer program that activates a link to the URL.

12. As to claim 22, Callaghan discloses the method further comprising placing a sharable file on the computer in response to the user registering with the first web site for or regarding the first product or the first service, wherein the sharable file is placed on the computer by the first

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web site, wherein the shareable file includes a second URL, and further wherein the second URL corresponds to or is associated with the first web site [Fig. 7a «items 714, 718»: user login in results in cookie from ibm.com].

13. As to claim 23, Callaghan discloses the method further comprising wherein the program is a server side program [Fig. 8a «item 804»].

14. As to claim 24, wherein the program is a CGI script [column 1 «lines 33-36»], a Java servlet, a PHP script, or a Perl script.

15. As to claims 29-34, they do not teach or further define over the limitations of method claims 19-24, respectively. Claims 29-34 are therefore rejected for at least the same reasons set forth for claims 19-24.

16. As to claim 36, as further discussed above in the “Claim Interpretation” section, because it does not affect the structure of the claimed system, the limitation does not limit the claim's scope and therefore is not given any patentable weight.

17. As to claims 37 and 38, they do not teach or further define over the limitations of method claims 19 and 22, respectively. Claims 37 and 38 are therefore rejected for at least the same reasons set forth for claims 37 and 38.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 25, 26, and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Callaghan in view of Applicant's admitted prior art.

19. As to claims 25, 26, and 35, Callaghan does not disclose wherein said program is a client side program that is downloaded from the second Web site wherein the program is at least a Java applet or an ActiveX control. However, such a feature was well known in the art at the time of Applicant's invention as evidenced by Applicant's admitted prior art. Applicant states "ActiveX controls and Java applets used to access the file system were well-known to those reasonably skilled in the art at the time of the present invention." See page 34, lines 1-7 of the appeal brief filed 6/3/2005. Thus, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Callaghan by adding the ability for the program to be a client side program such as ActiveX controls or a java applet that is downloaded from the second Web site as provided by the admitted art.

20. Claim 27 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Callaghan in view of Official Notice.

21. Callaghan does not expressly disclose the use of a wireless link. However, the rejection takes official notice that wireless communications were well known in art at the time of Applicant's invention. It would have been obvious to one of ordinary skill in the art to have modified Callaghan to include wireless communications. Such a modification is an example of simple substitution of one known element (wireless link) for another (Callaghan's wired link) to obtain predictable results. *See* MPEP § 2143.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571.272.3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dohm Chankong/
Primary Examiner, Art Unit 2452